

REMARKS

This Amendment is intended as a full and complete response to the non-final Office Action dated June 13, 2005. In the Office Action, the Examiner states that claims 1-24 are pending, of which claims 5, 9, 10, 12, 20 and 21 are withdrawn from consideration, and claims 1-4, 6-8, 11, 13-19 and 22-24 stand rejected. By this Amendment, claims 2, 6, 18, 22, and 23 have been amended and claims 1, 3, 4, 7, 8, 11, 13-19 and 24 continue unamended.

In view of both the amendments presented above and the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provision of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

A. Allowable Subject Matter

The Examiner has objected to claims 6-8 and 11 as being dependent upon a rejected base claim. The Examiner concludes that these claims would be allowable subject matter if rewritten in independent form including all the limitations of the base claim and any intervening claims.

The Applicant thanks the Examiner for indicating the allowable subject matter with respect to these claims. However, in view of the arguments set forth herein, the Applicant believes base claim 1 (and all intervening claims) is in allowable form and, as such, the dependent claims 6-8 and 11, as they stand, are therefore in allowable condition.

I. Objections

The Examiner has objected to claim 22 because one of the elements was inadvertently misnamed. In particular, “locking element (31)” was misnamed as “pawl element (31).”

The Applicants have amended claim 22 to correct the nomenclature of the feature that the Applicant considers as being inventive. In particular, the Applicant has amended “pawl element (31)” to “locking element (31).” Therefore, the Applicant respectfully requests that the objection be withdrawn.

II. Rejections

A. 35 U.S.C. § 112

Claims 6-8, 11, 18, and 23 stand rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

1. Claim 6

The Applicant has amended dependent claim 6 to further clarify the features the Applicant considers being inventive. In particular, amended claim 6 recites:

“A setting tool according to claim 4, wherein the locking element (31) is pivotally supported on an axle (44) secured on a servo-component (43) that is displaceable in the setting tool (10).”

Claim 6, as amended, provides proper antecedent basis for the element “servo-component (43),” as well as properly defines that the servo-component is displaceable in the setting tool (10). Support for the servo-component feature of claim 6 can be found in Applicant’s specification on page 6, lines 3-13. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

2. Claim 18

The Applicant has amended dependent claim 18 to further clarify the features the Applicant considers being inventive. In particular, amended claim 18 recites:

“A setting tool according to claim 4, wherein the locking element (31) is entrained when the ignition unit (12) is displaced from the ignition position (29) thereof to the pre-loaded position (28) thereof.”

Claim 18, as amended, clearly defines that the locking element (31) is entrained when the ignition unit (12) is displaced from the ignition position to the pre-loaded position. Support for the features of claim 18 can be found in the Applicant’s specification of page 6, lines 3-13. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

3. Claim 23

The Applicant has amended dependent claim 23 to correct a grammatical error regarding the second instance of the element "stop (17)." In particular, the Applicant has amended claim 23 to:

"A setting tool according to claim 22, further comprising a damping element (20) supported against the stop (17), and wherein the pawl section (42) of the locking element (31) is spaced from the stop (17) provided in the housing (11), in the locking position (38) of the locking element (31), by a distance corresponding substantially to the axial length of the ignition unit (12) and an axial length of the damping element (20)."

Claim 23, as amended, clearly defines that the second instance of the term "stop (17)" is the same element as recited in the first instance of "stop (17)." Support for the stop feature of claim 23 can be found in Applicant's specification on page 12, lines 9-18 and FIG. 1 of Applicant's drawings. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

B. 35 U.S.C. § 103

Claims 1-4, 13-19 and 22-24 stand rejected under 35 U.S.C. §103 as being obvious over US Patent No. 4,804,127 to Kirkman, in view of US Patent No. 6,286,743 to Ehmgig. The Applicant respectfully traverses the rejection.

Independent claim 1 recites:

"A setting tool, comprising a sleeve-shaped housing (11); a piston guide (13); a piston (15) displaceable in the piston guide (13); an ignition unit (12) located in the housing (11) and axially displaceable therein; a cartridge chamber (18) arranged between the piston guide (13) and the ignition unit (12), the ignition unit (12) having a cartridge chamber bottom (19) for enclosing a propellant (25) in the cartridge chamber (18) and an ignition element (22) for igniting the propellant (25); and a locking device (30) having a locking position (38) in which the ignition unit (12) is held in a pre-loaded position (28) against an energy accumulator (23) and in which the cartridge chamber (18) remains open, and having a release position (39) in which the ignition unit (12) is displaced to an ignition position (29) thereof by the energy accumulator in which the cartridge chamber bottom (19) closes the cartridge chamber (18)." (emphasis added).

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. § 102 for analyzing the features of a claim with respect to the prior art. It is well settled that [t]he test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The combination of Kirkman and Ehmig fails to teach or suggest the Applicant's invention as a whole.

The Kirkman patent discloses a fastener driving gun that has a firing pin (19/13F), a breach block (18), and a cartridge magazine strip guide (60). The breach block (18) includes a firing pin (19) slidably received therein. The firing pin (19) of Kirkman fails to teach or suggest "a cartridge chamber bottom for enclosing a propellant in the cartridge chamber."

Rather, the cartridge magazine strip guide (60) encloses a strip block (36) that forms a "cartridge chamber bottom," which encloses a propellant in a cartridge chamber (14C). The strip block (36) is fixed within the housing (11) and is provided with a cartridge access aperture (36) for receiving the firing pin (13F). The strip block, which functions as the cartridge chamber bottom, includes a lever (33), which is part of the trigger mechanism.

In particular, "[a] sear release pin 31 has its lower end pivotally connected as by a pin 32 to a sear release lever 33. The forward end of lever 33 is pivotally connected as by pin 34 to the bottom of a cartridge strip block 36 secured in the receiver 13." (see Kirkman, col. 2, lines 48-52). Accordingly, the Kirkman patent teaches a fixed strip block (36) that is part of the triggering mechanism that cannot be part of the moveable ignition unit.

Furthermore, the Ehmig patent fails to bridge the substantial gap as between the Kirkman patent and the Applicant's invention. In particular, Ehmig discloses an explosive powder charge-operated setting tool having a guide cylinder 1 and a breech block 2 coaxially arranged relative to each other. The end region of the guide cylinder 1 adjacent to the breech block 2 is provided with a cartridge socket 3 for receiving a cartridge 4. A mating surface 14 formed by an end surface of a cylindrical section of the

breech block 2 adjacent to the cartridge socket 3 partially encloses a propellant 4 in the cartridge socket (chamber) 3. (See Ehmig, col. 3, lines 19-57).

The Ehmig patent fails to teach or suggest that the breach block is part of an ignition unit or is moveable itself. Rather, Ehmig merely discloses that the breach block and the guide cylinder are displaceable “relative” to each other (see Ehmig, col. 3, lines 23-34).

Even if the two patents could somehow be operably combined, and the Applicant submits that the two patents cannot be operably combined, the combination of Kirkman and Ehmig still fails to teach or suggest “the ignition unit having a cartridge chamber bottom for enclosing a propellant in the cartridge chamber” and “a release position in which the cartridge chamber is displaced to an ignition position thereof by the energy accumulator in which the cartridge chamber bottom closes the cartridge chamber.”

The mating surface 14 of Ehmig cannot be combined with the breech block 18 of Kirkman, since the Kirkman patent alternatively utilizes a firing pin 19 that extends through the aperture 36A of the cartridge strip block 36. Rather, the fastener driving gun would be inoperative if the mating surface 14 of Ehmig was combined with the breach block 18 of Kirkman, since the mating surface would never come into contact with the propellant.

Moreover, the combined patents fail to teach or suggest that the cartridge chamber bottom is moveably attached with the ignition unit. By contrast, the Applicant’s invention provides for a locking position in which the ignition unit, which includes the cartridge chamber bottom, is held in a pre-loaded position in which the cartridge chamber remains open, and a release position, in which the cartridge chamber bottom closes the cartridge chamber.

Accordingly, since the combined patent fail to teach or suggest “the ignition unit (12) having a cartridge chamber bottom (19) for enclosing a propellant (25) in the cartridge chamber (18),” and “the ignition unit (12) is displaced to an ignition position (29) thereof by the energy accumulator in which the cartridge chamber bottom (19) closes the cartridge chamber (18),” the cited patents fails to teach or suggest the Applicant’s invention as a whole.

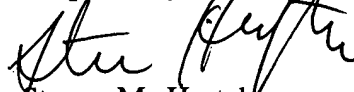
As such, the Applicant submit that independent claim 1 is not anticipated and fully satisfies 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 2-4, 13-19 and 22-24 depend, either directly or indirectly, from independent claim 1 and recite additional features of the invention. For at least the same reasons discussed above, the Applicant submits that these dependent claims fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the claim rejections be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned at (212) 885-9383 so that the appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,


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